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WELDON, U

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| ART UNIT | PAPER NUMBER |
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2609

DATE MAILED: 03/12/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on Feb. 29, 1996  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

|   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1.  Claims 95, 96, 98-110 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 1-94, 97 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 95, 96, 98-110 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1835 C.D. 11; 453 O.G. 213.

14.  Other

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 95, 96, 98-110 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of 5,146,215. Although the claims are not identical, they are not patentably distinct from each other because the claims of the present case are broader than the claims in U.S. Patent no. 5,146,215. Therefore, the claims in the said patent contain all the limitations in the claims of the present case.
3. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome a rejection on this ground. See MPEP 804.02 and 1490.
4. Applicant's arguments filed February 29, 1996 have been fully considered but they are not deemed to be persuasive.

Applicant has stated that column 4, lines 31-42 "does not suggest arming after receipt of an authorized code and subsequent disarming if another received code is correct." The examiner concurs with applicant's statement. However, column 4, lines 31-42 of Pinnow does suggest arming on receiving a code be it an

authorized code or not. This section of Pinnow further suggests that when the arming code is an authorized code, a disarming act will take place and the lock will open.

Pinnow teaches a control unit with a digital memory (col. 9, line 19) which can be programmed by a transmitting unit. PINNOW IN COLUMN 2, LINE 1-3 DISCLOSES THAT IT WAS KNOWN IN THE ART TO PROGRAM A TRANSMITTER DURING MANUFACTURING. In column 3, lines 16-18, Pinnow suggests the transmitter MAY be reprogrammed. This suggests the transmitter need not be reprogrammed or can be preprogrammed during manufacturing.

Sander et al have been cited to indicate that arming and disarming means have been long known in the art (see decision below). Also, as previously pointed out, "Applicant does not deny that, as of the effective filing date of this application, remote control vehicle security systems were known, which were armed or disarmed by the remote transmitter".

Factual Reference Need Not Antedate .

In re Langer, 183 USPQ 288 (CCPA 1974)

Even though effective date, for prior art purposes, of many of the references is subsequent to applicant's earliest filing date, the references are properly-cited for purpose of showing a fact.

In re Wilson, 135 USPQ 442 (CCPA 1962)

A bulletin published by a chemical company could be used as evidence of factual characteristics of prior art in foam products

in determining patentability of a process for making foamed polyester materials, even though date of the publication was later than the filing date of the patent application.

Applicant has recognized, "whether the user programs the card or not is not addressed by the reference (i.e. Aydin)". Hence, it is obvious that a user or anyone could preprogram the unit.

To eliminate Sander et al as reference, applicant's declaration should show his invention predates Sanders et al application serial number 588, 574 filed March 12, 1984. Further, "Applicant does not deny that, as of the effective filing date of this application, remote control vehicle security systems were known, which were armed or disarmed by the remote transmitter."

Applicant has erroneously stated that the dependent claims "stand allowable as patentably distinct from the invention of claim 95." Pinnow ('046) suggests program switch accessible. As pointed out above, manufacturer encoding is not precluded by the art of record.

Applicant's Declarations have been fully considered but they are not deemed to be persuasive.

The reasons for ordering a large number of microprocessors have not been completely associated with the success of any device. These processors could have been used in other device or

the price of these processors could have been the determining factor.

The applicant has stated, "The invention has literally obsoleted systems which do not include electronic programmability of access code in accordance with my invention, to the point that every single remote control security system model sold the assignee Clifford Electronics, Inc. (Clifford) and its affiliates today incorporates the invention." This statement does set forth when applicant invention was first included in "every single remote control security system model sold by" Clifford.

Applicant has further stated, "My invention has outdated conventional system because it provides tremendous advantages to the manufacturer, the installer, and to the end user of vehicle security systems." This statement does not establish: 1) what were the conventional systems outdated; 2) how did the installer secure the product from the manufacturer; and 3) could the installer participate in special advertising campaigns?

Here note applicant further states, "Clifford's sales of over one million units of vehicle security systems which incorporate this invention have been in the aftermarket, i.e. sales to customers who install the security system in previously manufactured vehicles". Here again applicant has not shown that these "sales to customers" were not initiated because of additional incentives which were not offered by "the conventional vehicle security systems."

Applicant next states, "Clifford's aftermarket competitors have realized the tremendous advantages provided by the invention at issue here, to the extent of copying the invention and incorporating it in their own product." First, note an invention is defined by the claims in an application. Second, applicant has not shown that each limitation in his claims can ~~find~~ <sup>be</sup> a corresponding element or limitation in each system in his Exhibits A and B. Third, applicant has not established that each claimed limitation can be found in the Clifford's aftermarket system. Fourth, in view of the above statements, it is not clear as to what applicant is referring to as "my invention".

If General Motors and other car companies use a system similar to applicant's invention, it has not been established when they started using such system. Also, it has not been shown how sales of the car companies cars with such systems similar to applicant's invention correlate to the "year by year" increase in sales of the Clifford's system.

In short, the Declaration by the applicant does note: 1) clearly define what applicant defines as "my invention"; 2) clearly establish over what period the sales occurred; 3) clearly show that no incentives were used to increase sales; 4) clearly show how long Clifford has used applicant's invention in all models.

5. Claims 95, 96, 98-110 are rejected under 35 U.S.C. § 103 as being unpatentable over Pinnow ('046) in view of Aydin, Tolson, and Sanders et al.

Pinnow teaches an electronically programmable remote control vehicle (column 4, lines 43-47) security (e.g. locking) system comprising a portable hand-held (e.g. pencil watch. See column 3, line 6) transmitter comprising means (column 2, line 55) for generating and transmitting a determined digitally encoded receiver signal or signals (column 3, lines 14-16), actuating means 24 for actuating said generating and transmitting means (column 3, lines 35-40 suggest plural key or transmitting means) so that said signal or signals are automatically generated and transmitted; a system control unit to obviously be disposed within said vehicle comprising receiving means 48 operable during a system program mode and a system operating-receiving mode for receiving said transmitted encoded signal and generating an electrical signal representative of the encoded signal by amplifier 50; a digital memory (column 9, lines 17-25) for storing data representative of control signal; programming and operating means 52. Pinnow does not teach a radio frequency system.

At the time that the invention was made, Tolson (column 3, lines 53-62) had disclosed the interchangeability of a light and radio system. One of ordinary skill in the art having Tolson

would readily find obvious that the teaching in Tolson could be used to substitute a radio signal for a light signal in Pinnow.

In column 2, lines 50-54, Pinnow points out that his invention can be used to replace a card. Aydin (column 9, lines 30-32) teaches a predetermined time delay means which can be used in a programmable security system. Since Pinnow's invention can be substituted for a card in Aydin, the teaching in Aydin can obviously be used in Pinnow because their teachings are interchangeable.

In column 6, lines 4-6, Pinnow suggests the next code received by a lock from a transmitter will reprogram the lock and the transmitter can have minimum features. The key 15 in Aydin has a minimum of features and is preprogrammed as set forth in the claims. As set forth in column 4, lines 29-34 of Aydin, the preprogrammed key can reprogram a lock as suggested in Pinnow. These preprogram and reprogram codes would not be known by a user as required by the claims. Aydin also uses such a wireless key in column 3, lines 66-67.

One of ordinary skill in the art having Aydin would be motivated to use a minimum feature transmitter as suggested in Aydin in Pinnow.

At the time that the invention was made, the patent to Sanders et al, in view of the interchangeable wireless teaching in Tolson, had disclosed that a wireless unit as set forth in Pinnow could be used to arm or disarm a security device.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. Weldon whose telephone number is (703) 305-4389. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 350-4700.

U. Weldon/skf  
March 7, 1996

*U. Weldon*  
ULYSEES WELDON  
PRIMARY EXAMINER  
GROUP 2600